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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/863,500 | 05/23/2001 | Jamie Ader | 21178-12 | 9371 |
| 22877 | 7590 | 09/03/2004 | EXAMINER | |
| FERNANDEZ & ASSOCIATES LLP 1047 EL CAMINO REAL SUITE 201 MENLO PARK, CA 94025 | | | LASTRA, DANIEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/863,500 | ADER, JAMIE | |
| | Examiner | Art Unit | |
| | DANIEL LASTRA | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-11 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-11 and 13-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Claims 1, 3-11 and 13-27 have been examined. Application 09/863,500 (PERMISSION-BASED MARKETING AND DELIVERY SYSTEM AND METHOD) has a filing date 05/23/2001.

Response to Amendment

2. In response to Office Action dated 06/16/04, the Applicant cancel claims 2, 12 and added claims 26 and 27. Applicant amendment overcame the 35 USC § 112 rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-11 and 13-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al (U.S. 6,385,592).

As per claim 1, Angles teaches:

A permission-based marketing organization and delivery system, comprising:
a computer network having at least one server (see figure 2);

a plurality of user interface applications allowing at least one user to engage said computer network and said at least one server (see figure 11);

a central database for storing advertising information, end user information, and a *directory of content* (see column 12, line 63 – column 13, line 6), the central database being coupled to said computer network (see figure 11; column 3, lines 10-55; column 8, lines 31-44); and

a plurality of additional database components, said additional database components storing information to be accessed by said central database (see figure 11, items 68, 70, 72; column 13, lines 60-67),

wherein an end user can order content from the directory, and the end user permits promotional material and specifies which promotional material is to be included with content (see column 3, lines 10-67; column 14, lines 29-40).

As per claim 3, Angles teaches:

The system of claim 1, wherein the central database includes editorial material related to the content (see column 20, lines 10-50).

As per claim 4, Angles teaches:

The system of claim 1, wherein the central database includes promotional material related to the content (see column 15, lines 44-55).

As per claim 5, Angles teaches:

The system of claim 1, wherein the central database includes tracking data related to audience response to the content (see column 3, lines 1-9).

As per claim 6, Angles teaches:

The system of claim 1, wherein the computer network includes at least one computer terminal connected to the at least one server, the at least one computer terminal facilitating the use of the plurality of user interface applications (see figures 2 and 11).

As per claim 7, Angles teaches:

The system of claim 1, further comprising a search engine, said search engine being coupled to said computer network (see column 2, lines 21-45).

As per claim 8, Angles teaches:

The system of claim 1, wherein said plurality of additional database components includes an orders database (see figure 11, item 72; column 16, lines 10-27).

As per claim 9, Angles teaches:

The system of claim 1, wherein an end user is an additional computer network (see figure 11).

As per claim 10, Angles teaches:

A method of integrating licensors and *end users* of media and advertisers, the method comprising:

registering content and promotional material with a central database (see column 3, lines 10-67);

identifying common characteristics between content and promotional material (see column 3, lines 43-67);

and

allowing an end user to order content and to *permit promotional material and specify which promotional material is to be included with content* (see column 3, lines 10-67; column 17, lines 15-22).

As per claim 11, Angles teaches:

The method of claim 10, further comprising distributing performance data related to said content to licensors of content and to advertisers (see column 16, lines 10-56).

As per claim 13, Angles teaches:

The method of claim 11, further comprising matching advertisers with licensors and *end users* (see column 3, lines 42-67).

As per claim 14, Angles teaches:

The method of claim 10, further comprising delivering content and advertising to end users (see column 3, lines 42-67).

As per claim 15, Angles teaches:

The method of claim 10, further comprising providing a directory of content, editorial material related to the content, promotional material related to the content, and tracking data related to audience response to the content to the central database (see column 3, lines 1-9; column 15, lines 44-55; column 20, lines 10-50).

As per claim 16, Angles teaches:

The method of claim 10, further comprising providing a computer network including at least one computer terminal connected to at least one server (see figure 11).

As per claim 18, Angles teaches:

The method of claim 10, further comprising providing plurality of additional database components, said plurality of additional database components including an orders database (see figure 11, item 72).

As per claim 19, Angles teaches:

The method of claim 15, further comprising providing a computer terminal connected to the at least one server, the computer terminal allowing a user to interface with said computer network (see figures 2 and 11).

As per claim 20, Angles teaches:

A method of delivering content over a computer network, the method comprising:
identifying common characteristics between content and promotional material (see column 3, lines 10-67);
identifying common characteristics between the content and promotional material and an end user (see column 3, lines 43-67);
allowing the end user to order content and to *permit promotional material and* specify which promotional material is to be included with content (see column 3, lines 10-67); and
delivering content and advertising together in a common product (see column 3, lines 55-67).

As per claim 21, Angles teaches:

The method of claim 20, further comprising accepting registration of content, promotional materials and end users (see column 3, lines 10-67).

As per claim 22, Angles teaches:

The method of claim 20, further *comprising* providing a computer network including at least one computer terminal connected to at least one server (see figures 2 and 11).

As per claim 23, Angles teaches:

The method of claim 20, further comprising providing a search engine (see column 2, lines 23-45).

As per claim 24, Angles teaches:

The method of claim 20, further comprising providing plurality of additional database components, said plurality of additional database components including an orders database (see figure 11, item 72).

As per claim 25, Angles teaches:

The method of claim 20, further comprising providing a computer terminal connected to the at least one server, the computer terminal allowing a user to interface with said computer network (see figures 2 and 11).

As per claim 26, Angles teaches:

The system of claim 1 wherein if the end user permits promotional material, a subsidy from the included promotional material applies to the ordered content (see column 16, lines 27-50).

As per claim 27, Angles teaches:

The method of claim 10 wherein if the end user permits promotional material, a subsidy from the included promotional material applies to the ordered content (see column 16, lines 27-50).

Response to Arguments

4. Applicant's arguments filed 06/14/04 have been fully considered but they are not persuasive. The Applicant argues that '592 does not disclose any possibility that users avoid advertisements but only that users may customize advertisements received. The Examiner answers that claim 1 recites "wherein an end user can order content from the directory, and the end user permits promotional material and specifies which promotional material is to be included with content". Angles teaches a system that target advertisements to users based upon the users indicated interest (see column 3, lines 10-67; column 14, lines 29-40). One of the purpose of the Angles system is to resolve the problem of promoting goods or services to the improper audience (see column 2, lines 33-35). Angles gives users the ability to specify the type of advertisements that the users would like to receive, and Angles use this information to avoid transmitting advertisements not selected by the users. This feature would avoid wasting time and money in transmitting advertisements to the improper audience.

Conclusion

5. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

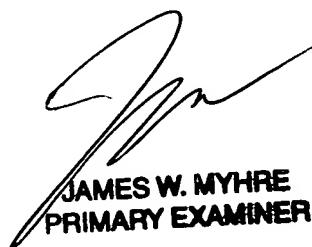
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
August 27, 2004



JAMES W. MYHRE
PRIMARY EXAMINER